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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,607	12/19/2001	Kenneth W. Aull	15-0254	3015

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EXAMINER

KHOSHNOODI, NADIA

ART UNIT PAPER NUMBER

2133

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,607

Applicant(s)

AULL ET AL.

Examiner

Nadia Khoshnoodi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/19/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/1-07-2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show element 148 in fig. 1 as described in the specification. Furthermore, the Certificate Authority has been referred to as element 1109 on page 7 of the specification. Also various elements (for example, 114 and 116) have not been referred to in the specification but are depicted in fig. 1. Please review figures and the specification to ensure that all figure elements referred to in the specification are depicted and referred to correctly and vice versa. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 2 and 4-5 are objected to because of the following informalities: when using acronyms, they should first be spelled out at least once before referring to them in the condensed form. For example, the 'E' in "E-Form" should be spelled out at least once in order to indicate the meaning of what the 'E' stands for. Appropriate correction is required.

Claim Rejections - 35 USC § 102

I. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

II. Claims 1 and 11 is rejected under 35 U.S.C. 102(e) as being fully anticipated by Burn, United States Pub. No. 2003/0005291.

As per claim 1:

Burn teaches a token issuance and binding process comprising: providing a plurality of tokens, each token having a unique ID number stored therein (par. 6, lines 1-7 and par. 37, lines 1-3); generating a unique public/private key pair for each token (par. 36, lines 8-15); storing each token ID number and corresponding public key in a directory/database (par. 36, lines 16-19); storing each private key in its respective token (par. 36-37 and table 1, field name "User Certificate"); and binding a unique ID number of a user to a corresponding one of the plurality of

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tokens by storing said correspondence there between in the directory/database (par. 36-37 and fig. 5, element 140).

As per claim 11:

The limitations in claim 11 are similar in scope to the limitations disclosed in claim 1, thus it is rejected for the same reasons since it is merely the system that implements the rejected method claim.

Claim Rejections - 35 USC § 103

III. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 2-4, 9-10, 12-14, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burn, United States Pub. No. 2003/0005291.

As per claim 2:

Burn substantially teaches the process as applied to claim 1 above. Furthermore, Burn teaches the binding comprising forwarding the user ID number and token ID number to a CMS (Certificate Management System) along with E-form request and signature of the Tokenizing Officer (par. 41). Not explicitly disclosed by Burn is a Tokenizing Officer reviewing credentials of a user. However, Burn teaches the HTTP & web browser and Certificate Authority carrying out these tasks, thereby acting as the "Tokenizing Officer" and the "Certificate Management System." Therefore, it would have been obvious to a person in the art at the time the invention

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was made to modify the method disclosed in Burn to have the HTP, web browser, and java applet interacting together to form the tokenizing officer, while the Certificate Authority acts as the certificate management system. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 41-43.

As per claim 3:

Burn substantially teaches the process as applied to claim 2 above. Not explicitly disclosed by Burn et al. is the binding further comprising the CMS checking for redundant user tokens and revoking any such user tokens. However, in an alternative embodiment, Burn teaches that each HTP must be initialized distinctly and uniquely to be able to ensure the HTP being enrolled is the correct one. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate the ability to check and revoke any such tokens that are not distinct. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 47.

As per claim 4:

Burn substantially teaches the process as applied to claim 3 above. Furthermore, Burn teaches the binding further comprising the CMS filling in the E-form from its directory/database and forwarding the filled in E-form to the Tokenizing Officer (par. 44).

As per claim 9:

Burn teaches the process as applied to claim 1 above. Not explicitly disclosed by Burn is the process wherein providing a plurality of tokens comprises providing a plurality of USB

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(Universal Serial Bus) tokens. However, Burn teaches the use of a hardware token that could be implemented in various ways. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to have the hardware tokens comprise of USB tokens. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 46.

As per claim 10:

Burn teaches the process as applied to claim 1 above. Not explicitly disclosed by Burn is the process wherein providing a plurality of tokens comprises providing a plurality of smart cards. However, Burn teaches that a smartcard could be used in an alternate embodiment. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to have the hardware tokens comprise of smartcards. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 31.

As per claims 12-14 and 19-20:

The limitations in claims 12-14 and 19-20 are similar in scope to the limitations disclosed in claims 2-4 and 9-10, thus it are rejected for the same reasons since they are merely components of the system that implement the rejected method claims.

V. Claims 5-8 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burn, United States Pub. No. 2003/0005291 as applied to claim 4 above, and further in view of Hericourt et al. (U.S. Pub. No. 2002/0078347).

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As per claim 5:

Burn substantially teaches the process as applied to claim 4 above. Not explicitly disclosed by Burn is the binding further comprising the Tokenizing Officer reviewing data in filled in E-form and comparing against user credentials and returning same to CMS after signing. However, Hericourt et al. teach a certificate checker to verify the CA and the information received from it. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate, into the HTP, the ability to verify the information received from the CMS in order to validate the CA and the user credentials filled in using the database. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Hericourt et al., par. 3-4 and 80-82.

As per claim 6:

Burn and Hericourt et al. substantially teach the process as applied to claim 5 above. Furthermore, Burn teaches generating and wrapping at least a signature certificate/private and associated private key for the user in the unique public key of the token and returning same to the Tokenizing Officer (par. 44, lines 1-13). Not explicitly disclosed by Burn or Hericourt et al. is the binding further comprising the CMS validating the Tokenizing Officer's signature. However, Burn teaches that when the CA receives a message from the HTP it must be decrypted, hence verified. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to incorporate the ability to validate the HTP's signature. This modification would have been obvious because a person having ordinary skill in

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the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 44, lines 1-5.

As per claim 7:

Burn and Hericourt et al. substantially teach the process as applied to claim 6 above. Furthermore, Burn teaches the binding further comprising the Tokenizing Officer storing the signature certificate/private key for the user in the token (par. 44, lines 14-21).

As per claim 8:

Burn and Hericourt et al. substantially teach the process as applied to claim 7 above. Not explicitly disclosed by Burn or Hericourt et al. is the binding further comprising the user unwrapping the signature certificate/private key using the token private key stored in the token. However, Burn teaches the HTP unwrapping the signature certificate/private key stored in the token. Therefore, it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Burn to instead have the user unwrap the information in the token. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Burn in par. 44, lines 14-21.

As per claims 15-18:

The limitations in claims 15-18 are similar in scope to the limitations disclosed in claims 5-8, thus it are rejected for the same reasons since they are merely components of the system that implement the rejected method claims.

**References Cited, Not Used*

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. U.S. Patent No. 5,943,423
2. U.S. Patent No. 6,438,550

The above references have been cited because they are relevant due to the manner in which the invention has been claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nadia Khoshnoodi whose telephone number is (571) 272-3825. The examiner can normally be reached on M-F: 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nadia Khoshnoodi

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Examiner

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NK



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